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EXAMINER

CAMERON, ERMA C

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1762

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/602,487
Filing Date: June 23, 2003
Appellant(s): CASTRO ET AL.

MAILED
MAY 14 2007
GROUP 1700

Song Zhu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/29/2007 appealing from the Office action mailed 7/31/2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct. However, due to the withdrawal of the 112, second paragraph rejection of claims 127, 131, 148, 149 and 152-157, claims 127, 131, 148, 149, 152, 153, 155 and 157 are now objected to.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct, except for the following withdrawn rejections:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

35 U.S.C. 112, second paragraph over claims 127, 131, 148, 149 and 152-157.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,679,400

Tuch

10-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

a) Claims 94-126, 128-130, 132-147, 150-151, 158-163, 165-175, and 177-183 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 94, 110, 160, and 172, and those depending therefrom are unclear. The method steps do not accomplish the stated purpose of the claims, the application or

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depositing of a coating substance. The method steps merely require causing a coating dispenser or a stent to be moved such that the dispenser avoids application of coating substance in a space between frame structures. There are no active method steps of applying a coating substance and it is unclear if Applicant requires a coating step. The phrase "for the application of a coating substance" does not limit the claims to a coating method step in so much as it is an intended use. Prior art teaching moving dispenser/stent and avoiding application of coating substance in a space between frame structures (i.e., if no coating is applied anywhere) would read on the claims. The passive phrase "causing" regarding the stent/dispenser to be moved is so broad as to be meaningless as it would arise from all causes of movement, including initial placement of the stent in the stent holder, so long as such placement is along some portion of the pattern of the stent.

Examiner has given claims their broadest reasonable interpretation. For example, claim 103 requires that the stent be capable of moving, but does not require that the stent move. Claims 109, 119, 120, 126 contain similar language.

b) Claims 110, 111, 114, 117-120, 125, 126, 132, 156, and 159 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuch (5,679,400).

Tuch teaches coating a stent with a dispenser using spray bursts. Between spray bursts, there is a time delay during which the stent is moved or rotated (Example 9; Example 1). Such movement inherently follows a path defined by a pattern of a frame structure. For example, some portion of one of the many frame structures will provide a path from one position to

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another that would yield a rotational movement of the stent. Additionally, the frame structures define the stent, which is a tubular member, therefore a rotational path would be defined by frame structures of a tubular member.

The movement of the stent occurs between coating bursts, therefore, the movement avoids application of coating substance in a space between frame structures because, in fact, during this time of movement, application is avoided altogether.

Alternatively, it is noted that Tuch teaches coating only one half of the stent at a time (one end versus the other), therefore, coating is not applied in “a space” (singular) of the end not being coated. The claim requires only that application be avoided in a single space.

Tuch teaches the dispenser and stent being in close proximity and that the stent is moved in intervals. The dispenser and stent are “capable” of moving in the ways claimed by Applicant. Tuch teaches coating with polymers and therapeutic agents.

c) Claims 94-95, 98, 101-103, 109, 130, 140, 141, 154, 158, 160-163, 165-167, 172-175, and 177-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuch.

Tuch is applied here for the reasons given above.

What Tuch fails to specifically teach is that the dispenser may be moved instead of the stent. However is it Examiner position that all motion is relative. It would have been obvious to an ordinary artisan to move the dispenser in relation to the stent or to move both relative to each other with the expectation of similar, successful results.

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Tuch also fails to specifically teach operating the movement by computer. It is Examiner's position that performing an operation in an automated fashion, such as with a computer, instead of by hand would have been within the skill of an ordinary artisan and does not patentably distinguish the process.

(10) Response to Argument

a) 35 U.S.C. 112, second paragraph: Applicant argues that the coating step is not critical or essential to the invention and that Examiner may only reject a claim for lacking a critical or essential step when language from the specification makes it clear that the limitation is critical or essential for the invention.

Examiner notes that all method embodiments throughout the specification require application of a coating substance. For example, starting on p. 24 in "A Method for Coating a Prosthesis" section, several embodiments are outlined for moving a dispenser while **depositing** a composition, moving the holding assembly while **depositing** a composition, **depositing** a composition in a pattern or **depositing** it intermittently, etc. In fact, the entire method is directed to a process for coating, as evident from the title, method heading, description, and drawings.

b) Tuch reference: Examiner has cited the Tuch reference which teaches, in one embodiment, movement of a stent in such a way as to avoid application of coating in a space between the frame structures of the stent, by stopping the application of coating and rotating the stent. For

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that period of time, no material is applied to the stent, the spaces, or anywhere else, which does in fact meet the limitations of the claims, as written. The applicant has argued that it is inevitable that the coating substance is sprayed on the structures and in the spaces. However, while the spraying is stopped and the stent being rotated, application of the coating substance in the spaces is avoided.

The Tuch reference, in the second embodiment, teaches coating only one end. Clearly, all the spaces at the other end of the stent are avoided. The claims, as written, require only avoidance of the substance in "a space". The claim is open to application of coating substances through hundreds of spaces, as long as one single space is avoided.

Examiner notes that "for the application of the coating substance" is merely intended use.

It is noted that the art rejections clearly demonstrate why the claims, as written, are broader than what Applicant's arguments seem to imply and specification states is the invention.

In the absence of an active coating step in the claimed invention, a lack or stoppage of spraying would avoid coating the spaces and the stent and, as such, would still meet the claim limitations.

The applicant has argued that a coating step is not part of the claimed invention. Applicant cannot have it both ways. If, as Applicant argues, a coating step is not part of the claimed invention, then Examiner need not find a reference with a coating step to meet the limitations of the claims. A reference that involves movement of a dispenser and avoidance of application of coating meets the claims. As outlined in the previous office action, claim 94, for example, merely requires causing a dispenser to be moved along a path defined by a pattern, such that the dispenser avoids application of the coating substance in a space between the frame

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structures. The applicant has argued that the examiner's logic would lead to the absurd conclusion that stopping spraying means avoiding spraying onto the stent. However, most of the claims do not require application of the coating substance.

Regarding applicant's references to Figure 1 and 8-14 as well as to pages 24 to 27 of the specification, these are not the claims being examined.

Regarding claims 119 and 126, the claim language in each of these claims ("capable of") does not require that the action take place, only that the stent and dispenser have these capabilities.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Erma Cameron

Conferees:

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